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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,745	12/09/2004	Masanori Ogawa	2710-73568/DSD	1305
7590	03/08/2006			
Donald S Dowden Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036			EXAMINER LONEY, DONALD J	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 03/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/518,745		OGAWA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Donald Loney		1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Drawings***

1. Figure 16 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Horiki et al (4835026).

Horiki et al discloses a masking member 100 of foamed polystyrene with a thickness A wherein thickness of the panel between opposing grooves 102 is 0.30A-0.85A. This equates to the grooves taking up 15-70 % of the thickness of the panel, substantially encompassing the applicant's range of 10-70%. Adhesive 103 is also

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disclosed on the member per claim 4. Refer to figures 1, 2 and 5-9 along with the Abstract, Summary of the Invention and column 3, lines 25-36.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al (5206069).

Horiki et al discloses a masking member 111 of expanded polystyrene containing grooves 112 on both sides thereof. Refer to figures 4 and 5 along with the corresponding text thereto. Adhesive 114 is also disclosed per claim 4. Horiki et al does fail to specifically disclose the percent thickness of the panel that the grooves occupy (i.e. 10-70%) or the width of the grooves per claim 3. Horiki et al is silent as to these parameters.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Horiki et al to form the grooves taking up the percent thickness of the panel as recited motivated by the fact this would only involve a change in size and/or shape of an already known feature (i.e. the grooves have already been shown in the art). The same would apply to the width of the grooves. A change in size and/or shape of an already known feature is generally considered within ordinary skill in the art. See MPEP 2144.04IV.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al (4835026).

The primary reference teaches the invention substantially as recited except for specific width of the groove per claim 3. See the 35 U.S.C. 102 rejection above. Horiki et al is silent as to this parameter.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Horiki et al to form the grooves of the width recited

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motivated by the fact this would only involve a change in size and/or shape of an already known feature (i.e. the grooves have already been shown in the art). A change in size and/or shape of an already known feature is generally considered within ordinary skill in the art. See MPEP 2144.04IV.

9. Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al (4913786).

Horiki et al discloses a masking member 101 of expanded polystyrene containing grooves 102 on both sides thereof. Refer to figures 1-8 along with the corresponding text thereto. Adhesive 104 is also disclosed per claim 4. Horiki et al does fail to specifically disclose the percent thickness of the panel that the grooves occupy (i.e. 10-70%) or the width of the grooves per claim 3. Horiki et al is silent as to these parameters.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Horiki et al to form the grooves taking up the percent thickness of the panel as recited motivated by the fact this would only involve a change in size and/or shape of an already known feature (i.e. the grooves have already been shown in the art). The same would apply to the width of the grooves. A change in size and/or shape of an already known feature is generally considered within ordinary skill in the art. See MPEP 2144.04IV. The insert per claim 5 is shown as 172 in figures 22-24. The knob per claim 6 can be considered 173 and the rib per claim 7 can be considered 170 in figure 24.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney  
Primary Examiner  
Art Unit 1772

DJL:D.Loney  
03/06/06